

Docket No.: 336292US6SD/jkl

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: Fujio INOUE

SERIAL NUMBER: 10/518,087 GROUP: 3744
(US Patent No. 7,445,161)

FILED: December 16, 2004 EXAMINER: JIANG, Chen-Wen
(Issued: November 4, 2008)

FOR: THERMOSTAT

RENEWED PETITION UNDER 37 C.F.R. § 1.705(d) AND
REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT

MAIL STOP: PATENT EXT.
COMMISSIONER FOR PATENTS
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450

SIR:

Petitioners hereby request supervisory review of the decision by the Office of Petitions of July 23, 2009, dismissing the request for reconsideration of the patent term adjustment for US Patent No. 7,445,161 (the ‘161 patent) on the basis that the dismissal was improper for failure to consider the U.S. District Court for the District of Columbia’s opinion rendered in *Wyeth v. Dudas*, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008).

Petitioners further hereby request reconsideration of the final patent term adjustment for U.S. Patent No. 7,445,161 (“the ‘161 patent”) of 520 days, and in place thereof, Petitioners request that the patent term adjustment be changed to 844 days.

Petitioners contend that the Office erred in determining patent term adjustment published on the face of the '161 patent by not properly accounting for the period of time where issuance of the '161 patent was delayed beyond three years of pendency (35 U.S.C. §154(b)(1)(B)).

Correction of the foregoing error in the patent term adjustment is requested in view of the present Petition including the facts and remarks that follow.

Patent Term Adjustment indicated in the Notice of Allowance and on the '161 Patent:

On July 15, 2008, a Notice of Allowance was issued in U.S. Application Serial No. 10/518,087, which indicated that the determination of patent term adjustment under 35 U.S.C. §154(b) was 556 days. This patent term adjustment was calculated as the 579-day period in which the Office failed to mail one of either an action under 35 U.S.C. §132, or a notice of allowance under 35 U.S.C. §151 following expiration of 14 months from filing (37 C.F.R. §1.703(a)(1)) from which a 23-day period in which Petitioner failed to engage in reasonable efforts to conclude prosecution (processing or examination) of the application (37 C.F.R. §1.702(b)) is subtracted.

On November 4, 2008, the Office issued U.S. 7,445,161. On the face of the '161 patent a patent term adjustment of 520 days is indicated. This patent term adjustment corresponds to the total number of 579 days for which the patent was delayed (35 U.S.C. §154(b)(1)(A) from which a 59-day period in which Petitioner failed to engage in reasonable efforts to conclude prosecution (processing or examination) of the application (37 C.F.R. §1.702(b)) is subtracted.

Statute relevant to decision on Petition:

35 U.S.C. §154(b) provides for the patent term guarantees giving rise to an adjustment in patent term.

Specifically, 35 U.S.C. §154(b)(1) provides for the following adjustments to the patent term:

(1) PATENT TERM GUARANTEES.-

(A) GUARANTEE OF PROMPT PATENT AND TRADEMARK OFFICE RESPONSES.- Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the Patent and Trademark Office to-

(i) provide at least one of the notifications under section 132 of this title or a notice of allowance under section 151 of this title not later than 14 months after-

the date on which an application was filed under section 111(a) of this title; or

the date on which an international application fulfilled the requirements of section 371 of this title;

(ii) respond to a reply under section 132, or to an appeal taken under section 134, within 4 months after the date on which the reply was filed or the appeal was taken;

(iii) act on an application within 4 months after the date of a decision by the Board of Patent Appeals and Interferences under section 134 or 135 or a decision by a Federal court under section 141, 145, or 146 in a case in which allowable claims remain in the application; or

(iv) issue a patent within 4 months after the date on which the issue fee was paid under section 151 and all outstanding requirements were satisfied, the term of the patent shall be extended 1 day for each day after the end of the period specified in clause (i), (ii), (iii), or (iv), as the case may be, until the action described in such clause is taken.

(B) GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY.

- Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States, not including-

- (i) any time consumed by continued examination of the application requested by the applicant under section 132(b);
- (ii) any time consumed by a proceeding under section 135(a), any time consumed by the imposition of an order under section 181, or any time consumed by appellate review by the Board of Patent Appeals and Interferences or by a Federal court; or
- (iii) any delay in the processing of the application by the United States Patent and Trademark Office requested by the applicant except as permitted by paragraph (3)(C), the term of the patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued.

(C) GUARANTEE OR ADJUSTMENTS FOR DELAYS DUE TO INTERFERENCES, SECRECY ORDERS, AND APPEALS.

- Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to-

- (i) a proceeding under section 135(a);
- (ii) the imposition of an order under section 181; or
- (iii) appellate review by the Board of Patent Appeals and Interferences or by a Federal court in a case in which the patent was issued under a decision in the review reversing an adverse determination of patentability, the term of the patent shall be extended 1 day for each day of the pendency of the proceeding, order, or review, as the case may be.

Countering this period is the limitations enunciated in 35 U.S.C. §154(b)(2), which sets forth:

(2) LIMITATIONS.-

(A) IN GENERAL.- To the extent that periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.

(B) DISCLAIMED TERM. - No patent the term of which has been disclaimed beyond a specified date may be adjusted under this section beyond the expiration date specified in the disclaimer.

(C) REDUCTION OF PERIOD OF ADJUSTMENT. -

- (i) The period of adjustment of the term of a patent under paragraph (1) shall be reduced by a period equal to the period of time during which the applicant failed to engage in reasonable efforts to conclude prosecution of the application.
- (ii) With respect to adjustments to patent term made under the authority of paragraph (1)(B), an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of 3 months that are taken to respond to a notice from the Office making any rejection, objection, argument, or other request, measuring such 3-month period from the date the notice was given or mailed to the applicant.
- (iii) The Director shall prescribe regulations establishing the circumstances that constitute a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application.

Grounds for Request for Reconsideration and Reinstatement of Patent Term Adjustment:

At issue in this case is the Office's misapplication of the provision in 35 U.S.C. §154(b)(2) that states “[t]o the extent that periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.”

On the face of the '161 patent a patent term adjustment of 520 days is indicated. The Office determination of the 520-day patent term adjustment is in error in that, pursuant to 35 U.S.C. § 154(b)(1)(B), the Office failed to properly allow an adjustment for the time exceeding three years after the actual filing date of the present application (December 12,

2004) to the date when the '161 patent issued (November 4, 2008). The correct patent term adjustment for the '161 patent is 844 days.

In this case, the periods of patent term adjustment under 35 U.S.C. §154(b)(1)(A) and 35 U.S.C. §154(b)(1)(B) are calculated independently. The following is a summary of the time periods and the number of days of PTA:

35 U.S.C. §154(b)(1)(A)

Plus 579 days from February 16, 2003 (i.e., 14 months from the filing date of December 16, 2004) to September 18, 2007, when Office mailed a Non-Final Rejection (i.e., an action under 35 U.S.C. §132) (35 U.S.C. §154(b)(1)(A)(i) and 37 C.F.R. §1.703(a)(1)).

TOTAL patent term adjustment under 35 U.S.C. §154(b)(1)(A) = **579 days**.

35 U.S.C. §154(b)(1)(B)

Plus 324 days from December 16, 2007 (i.e., 3 years from the filing date of December 16, 2004) to November 4, 2008, when the present application issued as the '161 patent. No RCE was filed.

TOTAL patent term adjustment under 35 U.S.C. §154(b)(1)(B) = **324 days**.

35 U.S.C. §154(b)(1)(B) correction

Minus 59 days due to Petitioners' failure to engage in reasonable efforts to conclude prosecution of the application (35 U.S.C. §154(b)(1)(B) and 37 C.F.R. §1.702(b)).

35 U.S.C. §154(b)(2) states “[t]o the extent that periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.”

In *Wyeth v. Dudas*, 580 F. Supp. 2d 138, (hereinafter *Wyeth*), the Court issued an opinion explaining the proper method for calculating patent term adjustments under 35 U.S.C. § 154(b). Specifically, when determining the overlap defined in 35 U.S.C. §154(b)(2), the Court held that “[t]he only way that [A and B] periods of time can 'overlap' is if they occur on the same day.” *Id.* at 141-142. In other words, the A delay (i.e., delay under 35 U.S.C. §154(b)(1)(A)) and B delay (i.e., delay under 35 U.S.C. §154(b)(1)(B)) only overlap if the A delay occurs after three years of pendency.

With this proper frame of reference, Petitioners return to the calculation above. In this case, the A delay and the B delay do not overlap from September 18, 2007, (when Office mailed a Non-Final Rejection), to December 16, 2007, (which is 3 years from the filing date of December 16, 2004) thus resulting in **0 days**. The resulting calculation of the patent term adjustment for the '161 patent should be as follows:

A delay	B delay	35 U.S.C. §154(b)(2) correction	Applicant Delay	Total PTA
579	+ 324	- 0	- 59	= 844

The Office has taken the position that it is the entire period during which the application was pending before the Office (except for periods excluded under 35 U.S.C. §154(b)(1)(B)), and not just the period beginning three years after the filing date of the application, is the relevant period under 35 U.S.C. §154(b)(1)(B) in determining whether periods of delay “overlap” under 35 U.S.C. §154(b)(2)(A).

This interpretation made by the Office is inconsistent with the recent opinion made in *Wyeth* which clearly addresses the situation. *Id.* at 142. The Court states in part:

The problem with the PTO’s construction is that it considers the application *delayed* under § 154(b)(1)(B) during the period *before it has been delayed*. That construction cannot be squared with the language of § 154(b)(1)(B), which applies “if the issue of an original patent is *delayed* due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years.” (Emphasis added). “B delay” begins when the PTO has failed to issue a patent within three years, not before.

In view of the foregoing and supported by *Wyeth*, Petitioners respectfully request that the Office correct the error in the patent term adjustment for the ‘161 patent and properly indicate that the patent term adjustment has been changed to 844 days.

Since this is a renewed petition under the provisions of 37 C.F.R. §1.704(b) and (d), Petitioners believe there are no additional fees due under 37 C.F.R. §1.18(e). In the event that the Office determines that additional fees are required, it is requested that any underpayment be charged to their undersigned Representative’s deposit account (Deposit Account No. 15-0030).

For the foregoing reasons, Petitioners respectfully submit that the Renewed Request for Reconsideration of the Patent Term Adjustment of U.S. 7,445,161 should be GRANTED and the patent term adjustment should properly be indicated as 844 days. Early notification of such action is earnestly solicited.

Respectfully Submitted,

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